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JUN 23 2005

OFFICE OF PETITIONS

In re Application of	:
Joseph Rogozinski	: DECISION ON PETITION
Application No. 10/806,231	:
Filed: March 23, 2004	:
Attorney Docket No. 1231ROG-US	:

This is a decision on the petition under 37 CFR 1.137(a), filed March 16, 2005, to revive the above-identified application.

This application became abandoned for failure to reply timely to the Notice to File Corrected Application Papers mailed on June 4, 2004, which set a two-month extendable period to respond. Petitioner did not obtain any extensions of time for response. Accordingly, this application became abandoned on August 5, 2004. A Notice of Abandonment was mailed on February 18, 2005.

In the present petition, petitioner's agent, David Klein states that he is a solo practitioner without the assistance of a secretary. Mr. Klein indicates that he did not realize the application became abandoned until after he received the Notice of Abandonment. After an investigation of the matter, Mr. Klein determined that the Notice to File Corrected Application Papers arrived at his office in Israel by mail on or about June 21, 2004. Mr. Klein explains that on June 21, 2004, his daughter was struck and killed by an automobile. Mr. Klein asserts that due to this tragedy, the Notice to File Corrected Application Papers was overlooked and no response was sent.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in

compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".¹ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph,

¹ 35 U.S.C. § 133.

² In re Mattullah, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³

Initially, the Office extends its sympathy to the agent's family for the loss of their daughter. However, the showing required under 37 CFR 1.137(a) is extremely exacting. Mr. Klein acknowledges that the tragedy took precedence over prosecuting the application. Such a delay is not "unavoidable" within the meaning of 37 CFR 1.137(a). It is certainly understandable how the passing of a family member impacts an individual. However, the delay in taking action in the above-identified application constitutes a preoccupation with other matters, which does not form the basis of unavoidable delay.⁴

It is unclear from the petition if Mr. Klein is asserting that due to the tragedy, he was incapacitated to such a degree as to render him unable to conduct business from the due date for the reply until the filing of a grantable petition. A showing of "unavoidable" delay based on incapacitation must establish that Mr. Klein's incapacitation was of such a nature and degree as to render him unable to conduct business (*e.g.* correspond with the USPTO) during the entire relevant time period. Furthermore, to establish a showing of incapacitation, Mr. Klein must submit a statement from a treating medical professional and any medical records, which describe the nature and degree of the incapacitation during the aforementioned period.

Lastly, Mr. Klein has failed to show what steps, if any, he took after the tragedy to seek the assistance of another registered patent agent or attorney to ensure the timely filing of a response with the USPTO.

CONCLUSION

Petitioner has not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Accordingly, the petition must be **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

Alternative Venue

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from seeking relief by filing a petition under 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 1.17(m); (3) a statement that the entire delay in filing the

³ *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁴ See *Smith v. Mossinghoff*, 671 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
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Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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